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10/697,256

10/31/2003

Kazuo Okada

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EXAMINER

SHAH, MILAP

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

10/10/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/697,256

Applicant(s)

OKADA, KAZUO

Examiner

Milap Shah

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 17-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 3714

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 7, 2007 has been entered.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 recites "a lottery device for executing a lottery of a prize-winning combination and a stop order table..." which is unclear with regards to the "stop order table". Upon review of the specification regarding a "stop order table" it appears the gaming machine selects one of the stop orders within the stop order table, but doesn't select a stop order table itself, that is, the table comprises various stop orders. Thus, it is unclear how the lottery device selects a "stop order table" and not simply just a stop order for the prize-winning combination.

Claim 22 recites "the attraction control device" in line 3 of the claim. There is insufficient antecedent basis for this limitation in the claim. It appears the most recent amendments have canceled "an attraction control device" from independent claim 17, thus claim 22 should be amended accordingly and any reference to an attraction control device should be removed.

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishikawa (JP Publication No. 2000-300729). The English translation of abstract, detailed description, and claims was provided with a previous action.

**Examiner Note:** Applicant's attention is directed to MPEP 2114. This section discusses the interpretation of an apparatus claim based on structure versus function. While features of an apparatus may be recited either structurally or functionally, claims directed to the apparatus must be distinguished from the prior art in terms of structure rather than function. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claimed. See *Ex Parte Masham*, 2 USPQ2d 1647 (Board of Patent Appeals & Interferences, 1987); *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Federal Circuit, 1997); *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); and *In re Danby*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959).

The instant application is replete with apparatus claims (i.e. claims 17-22) containing portions directed to the particular function or operation of a claimed component of the apparatus rather than the physical structure of the apparatus. For example, claim 17 recites "an attraction display device for displaying an attraction image among predetermined attraction images, the attraction display being disposed in front of the shielding device" in which the recitation of the

function of the attraction display which displays an attraction image is considered intended use, however, the latter portion of the limitation referencing physical arrangement of the structural components is given patentable weight. An additional example are the three wherein limitations at the end of claim 17, each of the limitations appears to further indicate a function of the shielding device, however, none of the limitations further define or relate to the physical structure of the shielding device. Thus, if the Applicant intends for similar intended use limitations as possible distinguishing features of their claimed invention, they must be appropriately presented within the confines of method type claims.

Therefore, for the purposes of this action intended use limitations are considered to be capable of being performed by respective physical structural components of the prior art.

**Claim 17:** Nishikawa. disclose the same invention including a gaming machine comprising a plurality of variable display devices (figures 1 or 3[variable reel drums 2] and paragraph 0002), a stop control device (figure 2[control section 18 including a transducer 22 to control a motor for driving the reels in accordance with the game being played, such that the stop control device is used to stop the spinning of reels in response to stop buttons as described in paragraph 0002]), a lottery device (figure 2[CPU 18], where the CPU of a gaming machine utilizes a random number generator to generate a random lottery outcome), a determining device (i.e. the CPU 18 of the gaming machine also performs determination operations and paragraph 0001 discloses the gaming machine must have a “determination device” which essentially is the processor or CPU of the gaming machine), a shielding device and an attraction display device (Nishikawa discloses an LCD layer disposed in front of the variable reels, where the LCD is able to perform the task of a shielding device, where the reels are either shielded or shown and perform the task of an attraction

display device, where images are displayed on the LCD). As indicated above, the three “wherein” clauses at the end of claim 17 are considered mere intended use of the various devices.

Nishikawa, however, lacks specifically disclosing two separate structural components being a shielding device and an attraction display device, where the attraction display device is disposed in front of the shielding device. Regardless of this deficiency, the Applicant is directed to *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961) [see also MPEP 2144.04, section V, part C]. Summary of *In re Dulberg*: “The claimed structure, a lipstick holder with a removable cap, was fully met by the prior art except that in the prior art the cap is ‘press fitted’ and therefore not manually removable.” The court held that “if it were considered desirable for any reason to obtain access to the end of the prior art’s holder to which the cap is applied, it would be obvious to make the cap removable for that purpose.” The Examiner submits the same logic is applicable to the instant case as Nishikawa provides a similar invention, with the simple difference that Nishikawa performs two tasks with a single device (i.e. the transparent liquid crystal display performs both shielding and displaying of attraction images) and the instant application claims the same two tasks performed by two separate devices. Therefore, if it were desirable for any reason to perform such tasks by two separate devices, it would be obvious to one of ordinary skill in the art to use two separate devices for such a reason (i.e. the Applicant discloses that in Nishikawa it is difficult to display images effectively if both tasks are performed by a single device). For the purposes of patentability, making a single device separable into two devices is not considered to be patentably distinct. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Nishikawa to make the disclosed single display device separable into two devices effectively producing a shutter or shielding device and a separate image attraction display device for at least the reason that it may have been desirable to one of ordinary skill in the art for at

least the purpose of providing a special-purpose device for shielding and a special-purpose device for displaying attraction images so that extensive imaging be utilized on the attraction image device without the necessity to manage shielding simultaneously.

**Claims 18 & 19:** Nishikawa's liquid crystal display is considered an electronic shutter, as the display is a video display and "shutters" or blocks visibility of symbols via a colored or opaque state and enables visibility via a transmissive or semi-transmissive state. Additionally, as discussed above, it would have been obvious to make that separate electronic shutter device specifically for shielding.

**Claim 20:** As is the nature of electronic shutter devices (i.e. transparent liquid crystal displays), the shielding state being opaque and transparent is controlled by way of an applied voltage (figure 2).

**Claim 21:** As discussed before and now inclusive within the established separable tasks of shielding and displaying attraction images, Nishikawa discloses the structure of the liquid crystal display capable of being controlled by a "special games control device" (i.e. a portion or program within the game controller) for providing a special games state under a predetermined condition, where the attraction control device controls the shielding device during the special gaming state to display such arrangements as a bonus game (i.e. a special game), overtop the variable display device.

**Claim 22:** As described above, the limitation of claim 22 is considered an intended use limitation such that the limitation refers to the functions of the attraction control device versus modifying the structure of the device. Thus, the Examiner submits for purposes of patentability the appropriate structural components were described above and the remainder of claim 22 refers directly to the intended use of said devices, which are considered to be capable of performing said functional operations. See "Examiner's Note" above.

*Response to Arguments*

Applicant's arguments filed September 6, 2007 have been fully considered but they are not persuasive. The arguments were based upon amended claim language, thus, the response to rejections is incorporated in the updated rejections above. The grounds of rejection are maintained from the previous action.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milap Shah whose telephone number is (571) 272-1723. The examiner can normally be reached on M-F: 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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Art Unit 3714